

Patent

Docket No. 4216-4000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue of

Letters Patent 5,568,207

Richard CHAO

Serial No.: 09/182,862

Filed: October 21, 1998

For: AUXILIARY LENSES FOR EYEGLASSES

Examiner: H. Mai

Group Art Unit: 2873

OFFER TO SURRENDER PATENT

Commissioner for Patents
Washington, D.C. 20231

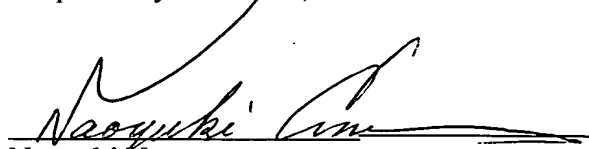
SIR:

I am empowered to sign this OFFER TO SURRENDER PATENT pursuant to 37 C.F.R. § 1.178 on behalf of the undersigned assignee, Asahi Kogaka Kogyo Kabushiki Kaisha (A.K.A. Asahi Optical Co., Ltd.), who is the assignee of the entire right, title, and interest of a one-half part of United States Patent No. 5,568,207 recorded on **May 24, 2000, Reel 010848, Frame 0278**.

The undersigned assignee offers to surrender United States Patent No. 5,568,207 for its reissue.

Respectfully submitted,

Date: March 27, 2001


Naoyuki Uno
Senior Managing Director
Asahi Kogaka Kogyo Kabushiki Kaisha
(A.K.A. Asahi Optical Co., Ltd.)

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Patent

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Letters Patent 5,568,207

Richard **CHAO**

Serial No.: 09/182,862

Filed: October 21, 1998

For: AUXILIARY LENSES FOR EYEGLASSES :

Examiner: H. Mai

Group Art Unit: 2873

**SUBMISSION OF SUPPLEMENTAL REISSUE
DECLARATION BY INVENTOR**

Commissioner of Patents
Washington, D.C. 20231

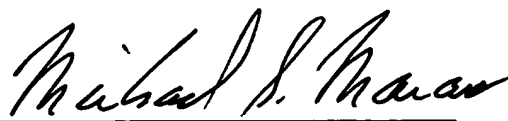
Sir:

Attached herewith is an executed Supplemental Reissue Declaration by Inventor, Richard Chao, for the above-identified reissue of U.S. Patent No. 5,568,207.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

Dated: March 29, 2001

By:



Michael S. Marcus

Registration No. 31,727
(202) 857-7887 Telephone
(202) 857-7929 Facsimile

CORRESPONDENCE ADDRESS:
MORGAN & FINNEGAN, L.L.P.
345 Park Avenue
New York, NY 10154

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09/182,862-070401

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue of

Letters Patent 5,568,207

Richard CHAO

Serial No.: 09/182,862

Filed: October 21, 1998

For: AUXILIARY LENSES FOR EYEGLASSES :

Examiner: H. Mai

Group Art Unit: 2873

SUBMISSION OF CONSENT OF ASSIGNEE

Commissioner of Patents
Washington, D.C. 20231

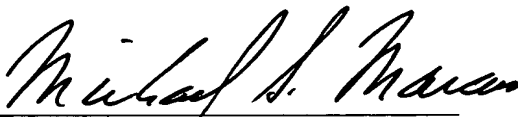
Sir:

Attached herewith is an executed Consent of Assignee by Asahi Kogaka Kogyo Kabushiki Kaisha (A.K.A. Asahi Optical Co., Ltd.), for the above-identified reissue of U.S. Patent No. 5,568,207.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

Dated: March 29, 2001

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Richard CHAO

Serial No.: 09/182,862

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For: AUXILIARY LENSES FOR EYEGLASSES

Commissioner of Patents
Washington, D.C. 20231

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Examiner: H. Mai

Group Art Unit: 2873

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CONSENT OF ASSIGNEE

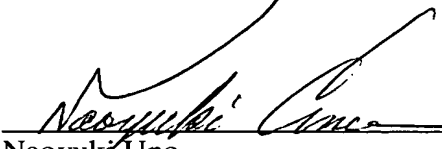
Sir:

I am empowered to sign this consent on behalf of the undersigned assignee, Asahi Kogaka Kogyo Kabushiki Kaisha (A.K.A. Asahi Optical Co., Ltd.), who is the assignee of the entire right, title and interest of an undivided one half part of United States Patent No. 5,568,207 recorded on **May 24, 2000, Reel 010848, Frame 0278.**

The undersigned assignee CONSENTS TO the reissue of United States Patent No. 5,568,207, which reissue was filed on October 21, 1998.

Respectfully submitted,

Date: March 27, 2001


Naoyuki Uno
Senior Managing Director
Asahi Kogaka Kogyo Kabushiki Kaisha
(A.K.A. Asahi Optical Co., Ltd.)

#25

Patent

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Examiner: H. Mai

Group Art Unit: 2873

TECHNOLOGY CENTER 2800

MAR 29 2001

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SUBMISSION OF OFFER TO SURRENDER PATENT

Commissioner of Patents
Washington, D.C. 20231

Sir:

Attached herewith is an executed Offer to Surrender Patent by Asahi Kogaka Kogyo Kabushiki Kaisha (A.K.A. Asahi Optical Co., Ltd.), assignee in the above-identified U.S. Patent No. 5,568,207.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

Dated: March 29, 2001

By: Michael S. Marcus
Michael S. Marcus
Registration No. 31,727
(202) 857-7887 Telephone
(202) 857-7929 Facsimile

CORRESPONDENCE ADDRESS:
MORGAN & FINNEGAN, L.L.P.
345 Park Avenue
New York, NY 10154

(d) The oath or declaration required by paragraph (a) of this section may be submitted under the provisions of § 1.53(f).

The reissue oath/declaration is an essential part of a reissue application and must be filed with the application, or within the time period set under 37 CFR 1.53(f) along with the required surcharge as set forth in 37 CFR 1.16(e) in order to avoid abandonment.

The question of the sufficiency of the reissue oath/declaration filed under 37 CFR 1.175 must in each case be reviewed and decided personally by the primary examiner.

Reissue oaths or declarations must contain the following:

(A) A statement that the applicant believes the original patent to be wholly or partly inoperative or invalid—

(1) by reason of a defective specification or drawing, or

(2) by reason of the patentee claiming more or less than patentee had the right to claim in the patent;

(B) A statement of at least one error which is relied upon to support the reissue application, *i.e.*, as the basis for the reissue;

(C) A statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant; and

(D) The information required by 37 CFR 1.63.

These elements will now be discussed:

I. A STATEMENT THAT THE APPLICANT BELIEVES THE ORIGINAL PATENT TO BE WHOLLY OR PARTLY INOPERATIVE OR INVALID BY REASON OF A DEFECTIVE SPECIFICATION OR DRAWING, OR BY REASON OF THE PATENTEE CLAIMING MORE OR LESS THAN PATENTEE HAD THE RIGHT TO CLAIM IN THE PATENT.

In order to satisfy this requirement, a declaration can state:

"Applicant believes the original patent to be partly inoperative or invalid by reason of a defective specification or drawing."

Alternatively, a declaration can state:

"Applicant believes the original patent to be partly inoperative or invalid by reason of the patentee claiming more or less than patentee had the right to claim in the patent."

Where the specification or drawing is defective and patentee claimed more or less than patentee had the right to claim in the patent, then *both* statements should be included in the reissue oath/declaration. See MPEP § 1412.04 for an exemplary declaration statement when the error being corrected is an error in inventorship.

The above examples will be sufficient to satisfy this requirement without any further statement.

Form paragraph 14.01 may be used where the reissue oath/declaration does not provide the required statement as to applicant's belief that the original patent is wholly or partly inoperative or invalid.

¶ 14.01 Defective Reissue Oath/Declaration, 37 CFR 1.175(a)(1) - No Statement of Defect in the Patent

The reissue oath/declaration filed with this application is defective because it fails to contain the statement required under 37 CFR 1.175(a)(1) as to applicant's belief that the original patent is wholly or partly inoperative or invalid. See 37 CFR 1.175(a)(1) and see MPEP § 1414. [1]

Examiner Note:

1. Use this form paragraph when applicant: (a) fails to allege that the original patent is inoperative or invalid and/or (b) fails to state the reason of a defective specification or drawing, or of patentee claiming more or less than patentee had the right to claim in the patent. In bracket 1, point out the specific defect to applicant by using the language of (a) and/or (b), as it is appropriate.

2. Form paragraph 14.14 must follow this form paragraph.

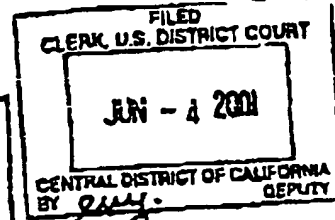
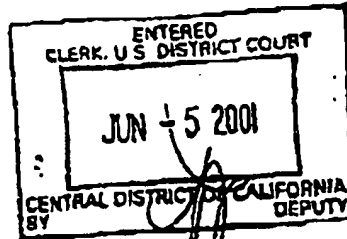
II. A STATEMENT OF AT LEAST ONE ERROR WHICH IS RELIED UPON TO SUPPORT THE REISSUE APPLICATION (I.E., THE BASIS FOR THE REISSUE).

A reissue applicant must acknowledge the existence of an error in the specification, drawings, or claims, which error causes the original patent to be defective. *In re Wilder*, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984). A change or departure from the original specification or claims represents an "error" in the original patent under 35 U.S.C. 251. See MPEP § 1402 for a discussion of grounds for filing a reissue that may constitute the "error" required by 35 U.S.C. 251. Not all changes with respect to the patent constitute the "error" required by 35 U.S.C. 251.

Applicant need only specify in the reissue oath/declaration one of the errors upon which reissue is based. Where applicant specifies one such error, this requirement of a reissue oath/declaration is satisfied. Applicant may specify more than one error.

Where more than one error is specified in the oath/declaration and some of the designated "errors" are found to not be "errors" under 35 U.S.C. 251, any remaining error which is an error under 35 U.S.C. 251 will still support the reissue.

The "at least one error" which is relied upon to support the reissue application must be set forth in the oath/declaration. It is not necessary, however, to point out how (or when) the error arose or occurred. Further, it is not necessary to point out how (or when) the error was discovered. If an applicant chooses to point out these matters, the statements directed to these matters will not be reviewed by the examiner, and the applicant should be so informed in the



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THIS CONSTITUTES NOTICE OF ENTRY
AS REQUIRED BY FRCP, RULE 77(d).

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

ASPEX EYEWEAR, INC.

Plaintiff,

v.

REVOLUTION EYEWEAR, INC.

Defendant.

CV 99-1623 LGB (BQRx)

ORDER GRANTING PLAINTIFF'S
MOTION FOR PARTIAL SUMMARY
JUDGMENT ON DEFENDANT'S
COUNTERCLAIM AND
AFFIRMATIVE DEFENSE OF
PATENT INVALIDITY

I. INTRODUCTION

This action arises out of Plaintiff Aspex Eyewear, Inc.'s allegation that Defendant Revolution Eyewear, Inc. is infringing upon its patent for magnetic eyewear. By the instant motion, Plaintiff seeks partial summary judgment on Defendant Revolution Eyewear Inc.'s counter-claim and affirmative defense of patent invalidity.

// ☒ Docketed
// ☒ Copies / NTC Sent
// ☒ JS - 5 / JS - 6
// ☐ JS - 2 / JS - 3
// ☐ CLSD

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1 II. FACTUAL BACKGROUND

2 Plaintiff purportedly has rights in U.S. Patent No. 5,568,207
3 (the "'207 Patent") for a particular type of magnetic "clip-on"
4 eyeglasses. See Def.'s Ex. 7 ('207 Patent). The patent was issued on
5 October 22, 1996, and identifies the inventor of the device disclosed
6 therein as a person by the name of Richard Chao ("Chao"). See id. at
7 1.

8 A. DESCRIPTION OF THE PATENTED DEVICE

9 The '207 Patent relates to an eyeglass device comprising a
10 primary spectacle frame for supporting primary lenses therein, and an
11 auxiliary frame (colloquially known as the "clip-on" frame) for
12 supporting auxiliary lenses. ('207 Patent, Abstract). The '207 Patent
13 specifies an arrangement whereby the auxiliary frame is engaged to the
14 primary spectacle frame using "magnetic members." See id. The two
15 magnetic members of the primary frame are secured within "projections"
16 that are in turn secured to the "rear and side portions" of the
17 primary spectacle frame. ('207 Patent, col. 1, lns. 50-52 & Fig. 3).
18 The two magnetic members of the auxiliary frame are secured to the
19 "arms," which are in turn secured to the two "side portions" of the
20 auxiliary frame. (Id. at col. 1, lns. 54-55 & Fig. 4). The arms of the
21 auxiliary frame extend over, and engage with, the upper portion of the
22 primary spectacle frame, such that the magnetic members of the two
23 frames engage with each other. (Id. at lns. 55-58 & Fig. 5). The
24 arrangement prevents the auxiliary frame from moving downward relative
25 to the primary spectacle frame, thereby enabling the auxiliary frame
26 to be stably supported. (Id. at col. 1, ln.62 - col.2, ln. 2).
27
28

1 B. DEFENDANT'S INVALIDITY COUNTERCLAIM

2 On February 17, 1999, Plaintiff filed suit against Defendant, on
3 the grounds that its magnetic eyewear infringed upon the '207 Patent.
4 See Pl.'s Compl. On March 11, 1999, Defendant filed a counterclaim,
5 seeking a declaration that the '207 Patent is invalid, and an
6 affirmative defense of invalidity. See Def.'s Counterclaim & Answer.

7 Defendant bases its invalidity claim on the contention that an
8 inventor by the name of Julie Madison ("Madison") is the first true
9 inventor of the device claimed in the '207 Patent. Madison is the
10 holder of U.S. Patent No. 6,149,269 (the "'269 Patent") for
11 "Eyeglasses Having Magnetically Held Auxiliary Lenses." See Def.'s Ex.
12 1 ('269 Patent). Madison applied for the patent on April 18, 1997, and
13 the '269 Patent was issued on November 21, 2000. See id. The '269
14 Patent describes itself as an improvement over prior art because of
15 its "uniblock" design:

16 Eyeglasses and clip-ons are improved by providing
17 housings for magnets for securing the clip-ons in a
18 uniblock also incorporating one or more of the
19 following: parts of closing block, an end piece, and
20 part of a hinge. The structure is more compact, neater
21 in appearance, and of improved quality as compared to
22 eyeglasses incorporating conventional structures . . .

23 See '269 Patent, Abstract. See also id. at col. 1, lns. 38-42
24 ("In eyeglasses constructed in accordance with the prior art, the
25 piecemeal assembly of closing block, end piece, magnet housing
26 and temple-piece hinge produces a structure that is unduly strung
27 out or elongate, and the housing for the magnet is bulky and
28 unsightly.") Significantly, the '269 Patent identifies the device
disclosed in the '207 Patent as a prior art reference. See id. at
1 (References Cited); id. at col. 1, lns. 13-25 ("Eyaglasses

1 equipped with one or more magnets adapted to secure an auxiliary
2 lens in superimposed relation to a primary lens are known and
3 disclosed for example in Chao U.S. Pat. No. 5,586,207.¹)

4 Madison purportedly began designing eyewear in or around
5 1978. See Madison Depo., Vol. 1 at 6. Madison asserts that, in
6 the summer of 1994, she conceived of a variety of embodiments for
7 eyeglasses that utilize a magnet to attach an auxiliary frame to
8 a primary frame, in a uniblock (also known as a "monoblock")
9 configuration.² See id. at 16:5-19:7; Madison Depo., Vol. 2 at
10 189-190. Madison claims that she conceived of a number of
11 orientations for the magnets during the summer of 1994, including
12 "magnets mounted on the front, magnets mounted on the top, and
13 . . . magnets mounted . . . vertically and horizontally." Id. at
14 24:16-23. Madison also purportedly conceived of a design whereby
15 the arms of the auxiliary frame would "go directly over" the
16 front portion of the primary frame. See id. at 25-27. Madison
17 apparently committed her ideas and designs to paper during 1994.
18 See id. at 27-28.³

19
20
21 ¹ As described by Madison, a monoblock configuration is one where
22 "all the parts, the rimlock, the hinge, and in this case the magnet, the
23 end piece, are constructed from a single piece of metal." Madison Depo.,
24 Vol. 1 at 45.

25 ² "Q: Now, did you prepare any notes or writing that related to
26 this conception?

27 A: Yes.

28 Q: And in what format did you maintain those notes?

A: Some are in notebooks, some are on -- depends on where I was.
Some were on box tops. Depending what I was doing at that
time. Some were on random pieces of paper."

See Madison Depo., Vol. 1 at 27-28.

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1 Also in the summer of 1994, Madison allegedly met with a
2 person by the name of Mr. Kimura, who worked for a company called
3 Sunreeve. See id. at 30; Madison Depo., Vol. 2 at 177. At their
4 meeting in Norwood, New Jersey, Kimura purportedly showed Madison
5 a sample of magnetic eyewear wherein the magnets were placed in a
6 front-mounted configuration. See Madison Depo., Vol. 1 at 32:21-
7 33:24. As they discussed the sample, Madison asserts that she
8 disclosed certain aspects of the invention she had conceived.
9 See id. at 34. Specifically, Madison purportedly discussed her
10 idea for magnetic eyewear with back-mounted magnets. See id.; see
11 also id. at 47 (Madison's testimony that she disclosed "the
12 substance of" her U.S. Patent application to Kimura). However,
13 Madison did not disclose any of her previously-made notes and
14 drawings to Kimura. See Madison Depo., Vol. 2 at 207-208.
15 Instead, Madison and Kimura purportedly made drawings during the
16 course of their meeting, incorporating Madison's uniblock design.
17 See id. In addition, Madison asked Mr. Kimura and Sunreeve to
18 create an eyeglass sample with top-mounted magnets and a
19 monoblock configuration. See id. at 177, 190. While Madison did
20 not enter into any formal confidentiality agreement with Kimura
21 or Sunreeve (see Madison Depo., Vol. 1 at 44:12-45:2), Madison
22 testified that she did expect Kimura to refrain from disclosing
23 her ideas and drawings to other people within the industry.
24 See Madison Depo., Vol. 2 at 210-211.'

25
26 ' "Q: Would it be fair to say . . . that your discussions with Mr.
27 Kimura that day in Anaheim when you went over these drawings were not
28 meant to be disclosed to anyone else in the industry?

A: I had expected that he would go back to his office and discuss
it with his technical people 'cause he's not a technical - although

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1 At a subsequent meeting in Anaheim, California in October of
2 1994, Kimura informed Madison that Sunreeve could not produce a
3 sample of a top-mounted monoblock design, because of the
4 technical difficulties it posed. See Madison Depo., Vol. 2 at
5 177-178; 190-192; 205:9-18. Thereafter, in April 18, 1997,
6 Madison applied for, and subsequently received, the '269 Patent.

7
8 III. PROCEDURAL BACKGROUND

9 Plaintiff filed the instant patent infringement action
10 against Defendant on February 17, 1999. Defendant filed an Answer
11 on March 11, 1999. Defendant also filed two counterclaims. The
12 first counterclaim seeks a declaration that its frames do not
13 infringe the '207 Patent, and the second counterclaim seeks a
14 declaration that the '207 Patent is invalid.

15 On June 2, 1999, Defendant filed a motion to stay this
16 action pending the conclusion of an interference proceeding by
17 the PTO to determine who, as between Richard Chao and inventor
18 Toshikazu Iwamoto, was the first to invent the device claimed in
19 the '207 Patent. On September 10, 1999, the Court ordered a stay
20

21 he's very bright, he's not the technical guy.

22 Q: Now, you expected him to talk to people within Sunreeve?

23 A: Right.

24 Q: Right. But you didn't expect him to go to talk to other people
25 within the industry?

26 A: Correct.

27 Q: Did you want him to keep the information a secret?

28 A: That would be yes."

See Madison Depo., Vol. 2 at 210-212.

1 of the action. On or about May 30, 2000, Richard Chao prevailed
2 in the interference proceeding, and the Court thereafter vacated
3 the stay on July 25, 2000.

4 On April 12, 2001, Plaintiff filed the instant motion for
5 partial summary judgment on Defendant's invalidity counterclaim
6 and affirmative defense. Defendant filed an opposition on April
7 23, 2001, to which Plaintiff replied on April 30, 2001.*

8
9 IV. SUMMARY JUDGMENT STANDARD

10 Rule 56 of the Federal Rules of Civil Procedure provides
11 that a court shall grant a motion for summary judgment if "the
12 pleadings, depositions, answers to interrogatories, and
13 admissions on file, together with the affidavits, if any, show
14 that there is no genuine issue as to any material fact and that
15 the moving party is entitled to judgment as a matter of law."
16 Fed. R. Civ. P. 56(c). Material facts are those that may affect
17 the outcome of the case. See Anderson v. Liberty Lobby, Inc.,
18 477 U.S. 242, 248 (1986). A dispute as to a material fact is
19 genuine if there is sufficient evidence for a reasonable jury to
20 return a verdict for the nonmoving party. See id.

21 The party moving for summary judgment bears the initial
22 burden of informing the district court of the basis of the
23 summary judgment motion, and of demonstrating the absence of a

24
25 * In its motion, Plaintiff also represents that Defendant agreed to
26 dismiss its fifth affirmative defense of statute of limitations, and its
27 ninth affirmative defense of laches. See Totino Decl. ¶2 & Ex. A.
28 Defendant's opposition does not indicate whether it agrees with this
representation. As these affirmative defenses are not made a part of
Plaintiff's motion for summary judgment, the Court will not dismiss such
defenses in the absence of a stipulation between the parties.

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1 genuine issue of material fact for trial. See Celotex Corp. v.
2 Catrett, 477 U.S. 317, 323 (1986); Katz v. Children's Hosp. of
3 Orange County, 28 F.3d 1520, 1534 (9th Cir. 1994). On an issue
4 for which the nonmoving party has the burden of proof at trial,
5 the moving party need only point out "that there is an absence of
6 evidence to support the nonmoving party's case." Celotex, 477
7 U.S. at 325. Once this initial burden is satisfied, the non-
8 moving party is required to "go beyond the pleadings and by her
9 own affidavits, or by the depositions, answers to
10 interrogatories, and admissions on file, designate 'specific
11 facts' showing that there is a genuine issue for trial." Celotex,
12 477 U.S. at 324 (internal quotations omitted). See also Nilsson,
13 Robbins, Dalgarn, Berliner, Carson & Wurst v. Louisiana Hydrolec,
14 854 F.2d 1538, 1544 (9th Cir. 1988). Where the standard of proof
15 at trial is preponderance of the evidence, the non-moving party's
16 evidence must be such that a "fair-minded jury could return a
17 verdict for the [non-moving party] on the evidence presented."
18 Anderson, 477 U.S. at 252.

19 V. ANALYSIS

20 A. LEGAL STANDARD FOR PATENT INVALIDITY

21 Patents enjoy a statutory presumption of validity. See 35
22 U.S.C. § 282 (1994). The party seeking to establish a patent's
23 invalidity must do so by clear and convincing evidence. Id.; Eli
24 Lilly & Co. v. Barr Laboratories, Inc., 222 F.3d 973, 980 (Fed.
25 Cir. 2000). "If the evidence requires the fact finder to draw
26 extensive inferences, the evidence does not satisfy the clear and
27 convincing proof requirement." Hay & Forage Industries v. New
28

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1 Holland North America, Inc., 60 F.Supp.2d 1099, 1119 (D.Kan.
2 1998).

3 "[A] moving party seeking to have a patent held not invalid
4 at summary judgment must show that the nonmoving party, who bears
5 the burden of proof at trial, failed to produce clear and
6 convincing evidence on an essential element of a defense upon
7 which a reasonable jury could invalidate the patent." *Id.*

8 A patent may be rendered invalid if it is anticipated by
9 prior art. Invalidity based on anticipation is described in 35
10 U.S.C. § 102(a):

11 A person shall be entitled to a patent unless -
12 (a) the invention was known or used by others in this
13 country, or patented or described in a printed
14 publication in this or a foreign country, before
15 invention thereof by the applicant for the patent.

16 See 35 U.S.C. §102(a). In essence, this statutory provision
17 requires an invention to be "new" in order to be patentable.

18 See 1 Chisum, Chisum on Patents, §3.01 at 3-3 (2000).

19 Here, Defendant argues that the Madison drawings disclosed
20 to Kimura constitute prior art that anticipates and invalidates
21 the '207 Patent. To withstand Plaintiff's motion for summary
22 judgment, Defendant must produce sufficient evidence to permit a
23 reasonable finder of fact to find patent invalidity on this basis
24 by clear and convincing evidence. See Anderson v. Liberty Lobby,
25 Inc., 477 U.S. at 254.⁵

26 ⁵ As a preliminary matter, plaintiff argues that Defendant is
27 precluded from arguing anticipation because Madison's own patent refers
28 to the Chao invention as a prior art reference. See '269 Patent at 1
(References Cited); *id.* at col. 1, lns. 13-25. "A statement in a patent
that something is in the prior art is binding on the applicant and
patentee for determinations of anticipation and obviousness." Constant

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1 B. APPLICATION

2 "A patent is invalid for anticipation when the same device
3 or method, having all of the elements and limitations contained
4 in the claims, is described in a single prior art reference." ATD
5 Corporation v. Lydall, Inc., 159 F.3d 534, 545 (Fed. Cir. 1998).

6 In order to invalidate a patent based on anticipation, the
7 Court must undertake a three-step analysis. First, the Court must
8 determine whether the purportedly anticipating invention is
9 indeed a prior art reference. See Purdue Pharma L.P. v.

10 Boehringer Ingelheim, GMBH, 237 F.3d 1359, 1365 (Fed. Cir. 2001).

11 In other words, does the reference pre-date the invention of the
12 patent-in-suit? Second, the Court must compare the claims of the
13 patent-in-suit to the prior art, to determine whether the prior
14 art reference discloses each and every limitation of the
15 invention claimed in the patent-in-suit. See Heliflix Limited v.
16 Blok-Lok Limited, 208 F.3d 1339, 1346 (Fed. Cir. 2000). See also
17 Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367

18 (Fed. Cir. 1986) ("It is axiomatic that for prior art to
19 anticipate under §102 it has to meet every element of the claimed
20 invention . . ."). Third, the Court must determine whether the
21 prior art reference was either "known or used by others in this

22 _____
23 v. Advanced Micro Devices, Inc., 848 F.2d 1560, 1570 (Fed. Cir. 1988).
24 Thus, Madison's description of the '207 Patent as a prior art reference
25 constitutes an admission of this fact as to Madison. However, Plaintiff
26 identifies no cases, and the Court has found none, indicating that the
27 scope of the admission extends to third parties seeking to raise an
28 invalidity defense. Thus, the Court is hesitant to rest upon this
admission alone in assessing the viability of Defendant's counterclaim.
Nevertheless, it is significant that Defendant places virtually
exclusive reliance upon Madison's deposition testimony to prove a
contention that Madison herself is barred from making.

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1 country", or "described in a printed publication in this or a
2 foreign country." 35 U.S.C. §102(a). Anticipation is a question
3 of fact that is subject to review under the clearly erroneous
4 standard. See In re King, 801 F.2d 1324, 1326 (Fed. Cir. 1986).

5 1. WHETHER THE MADISON INVENTION IS A PRIOR ART
6 REFERENCE

7 A reference constitutes prior art only if it
8 predates the date of invention of the device claimed in the
9 patent-in-suit. See 35 U.S.C. §102(a). The presumptive date of
10 invention for any device is the date upon which a complete patent
11 application is filed in the Patent and Trademark Office ("PTO").
12 See Cooper v. Goldfarb, 154 F.3d 1321, 1327 (Fed.Cir. 1998);
13 Bates v. Coe, 98 U.S. 31, 34 (1878). A patentee may establish an
14 earlier date of invention, however, by showing either (1) "an
15 earlier reduction to practice," (Purdue, 237 F.3d at 1365); or
16 (2) "an earlier conception followed by a diligent reduction to
17 practice." Id. "Conception and reduction to practice are
18 questions of law, based on subsidiary findings of fact." Id.

19 Here, the presumptive date of invention of Chao's eyeglass
20 device is November 7, 1995 -- the date Chao filed his patent
21 application with the PTO. See Pl.'s Ex. 7. The presumptive date
22 of invention of Madison's eyeglass device is seventeen months
23 later, on April 18, 1997 -- the date upon which Madison filed her
24 patent application. See Pl.'s Ex. 1. Thus, in order for Defendant
25 to establish that Madison's invention is a prior art reference,
26 it must raise a genuine issue of material fact that Madison
27 either reduced her invention to practice before November 7, 1995,
28 or conceived of her invention and diligently worked to reduce it

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1 to practice before November 7, 1995.

2 (a) Actual Reduction to Practice

3 To prove actual reduction to practice, "an
4 inventor must establish that he actually prepared the composition
5 and knew it would work." Estee Lauder Inc. v. L'Oreal S.A., 129
6 F.3d 588, 592 (Fed.Cir.1997); Markman v. Lehman, 987 F.Supp. 25,
7 30 (1997) ("Proof of actual reduction to practice requires a
8 showing that the apparatus actually existed and that it worked
9 for its intended purpose.") "To establish an actual reduction to
10 practice, an inventor must provide independent corroborating
11 evidence in addition to his or her own statements and documents,
12 such as testimony of a witness other than the inventor or
13 evidence of surrounding facts and circumstances independent of
14 information received from the inventor." Markman, 987 F.Supp. at
15 30. "The purpose of this rule is to prevent fraud." Id.

16 Here, Defendant does not attempt to provide any evidence
17 that Madison actually reduced her eyeglass device to practice.
18 prior to the filing of the Chao patent application on November 7,
19 1995. Indeed, the only evidence in the record is the
20 uncorroborated testimony of Madison that the first specimen
21 embodying her patented invention was produced in 1996. See
22 Madison Depo., Vol. 2 at 228-229. Thus, Madison cannot establish
23 priority on this basis.

24 (b) Conception and Diligent Reduction to
25 Practice

26 Defendant seeks to establish priority on the
27 alternative basis that Madison conceived of her invention, and
28 diligently worked to reduce it practice, prior to November 7,

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1 1995. Conception "requires proof that the inventor formed in his
2 mind 'a definite and permanent idea of the complete and operative
3 invention, as it is hereafter to be applied in practice,' and
4 that the idea be 'so clearly defined in the inventor's mind that
5 only ordinary skill would be necessary to reduce the invention to
6 practice, without extensive research or experimentation.'" Id.
7 (quoting Burroughs Wellcome Co. v. Barr Labs. Inc., 40 F.3d
8 1223, 1228 (Fed.Cir. 1994). Where a party seeks to show
9 conception through oral testimony of an inventor, it must produce
10 independent evidence corroborating that testimony. See Purdue,
11 237 F.3d at 1365. Indeed, "[p]roof of an alleged inventor's
12 conception and reduction to practice is a heavy one and requires
13 full corroboration by other than the inventor's own self-serving
14 testimony or records." Potter Instrument Co., Inc. v. Odeco
15 Computer Systems, Inc., 370 F.Supp. 198, 206 (D.R.I. 1974)
16 (quoting Eastman Kodak Co. v. E. I. DuPont de Nemours & Co., 298
17 F.Supp. 718, 728 (E.D.Tenn. 1969)).

18 In order to show due diligence in the inventor's reduction
19 to practice, "the patentee must account for the entire critical
20 period between the date of conception and the date of reduction
21 to practice by showing either activity aimed at reduction to
22 practice or legally adequate excuses for inactivity." American
23 Standard, Inc. v. Pfizer, Inc., 722 F.Supp. 86, 109 (D.Del. 1989)
24 (citing 3 D. Chisum, Patents § 10.07 (1987)). "In addition, the
25 law requires corroboration of diligence during the critical
26
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1 period." American Standard, 722 F.Supp. at 109.⁶

2 Relying on Madison's deposition testimony, Defendant
3 contends that Madison conceived of her magnetic eyewear in the
4 summer of 1994. See Madison Depo., Vol. 1 at 16:5-19:7; Madison
5 Depo., Vol. 2 at 185-190. The only purportedly corroborating
6 evidence provided by Defendant are declarations of Kimura and
7 Takahiro Nishioka (Deputy General Manager of Sunreeve) that were
8 allegedly submitted to the PTO in the prosecution of Madison's
9 patent. See Def.'s Opp'n. at 2; Def.'s Exs. 5 & 6. However,

10 Plaintiff properly objects to the admission of the declarations
11 because they are improperly authenticated. "In order for a

12 document to be considered by a court in ruling on a motion for
13 summary judgment, the document must be authenticated by and
14 attached to an affidavit that meets the requirements of

15 Fed.R.Rule.P. 56(e). . . ." See Countryside Oil Co., Inc. v.
16 Travelers Insurance Co., 928 F.Supp. 474, 482 (D.N.J. 1995).

17 "Hence, before evidence may be admitted, a foundation must be
18 laid 'by evidence sufficient to support a finding that the matter
19 in question is what its proponent claims.'" Id. (quoting Fed. R.
20 Evid. 901(a)).

21 Here, the supporting affidavit by defense counsel Crucillo
22 does not state that the declarations are "true and correct"
23 copies of what they purport to be. See Crucillo Decl. ¶¶ 6-7.

24 Indeed, the file history for Madison's '269 Patent nowhere

25
26
27 "The "critical period" of diligence is "from the time just before
28 the entry of a second inventor into the field until a reduction to
practice." American Standard, 722 F.Supp. at 114, n.21; Driscoll v.
Cebalo, 5 U.S.P.Q.2d 1477, 1481 n. 6 (P.T.O. 1982) (diligence is required
only "from a time prior to the conception of another").

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1 includes the foregoing declarations, and Defendant provides no
2 other evidence that the declarations were ever used in the patent
3 prosecution. See Totino Decl., Ex. A. Thus, the Court sustains
4 Plaintiff's objection to the admissibility of the declarations.

5 Even if the Court were to assume that conception occurred in
6 the summer of 1994, the record is devoid of evidence concerning
7 Plaintiff's diligent reduction to practice. Again, Defendant
8 relies on Madison's own deposition testimony, which is
9 insufficient as a matter of law because it is uncorroborated. See
10 American Standard, 722 F.Supp. at 109 ("the law requires
11 corroboration of diligence during the critical period.") Even if
12 the inadmissible declarations of Kimura and Nishioka are
13 considered, they are entirely silent as to Madison's attempts, if
14 any, to reduce her invention to practice. In fact, Nishioka's
15 declaration provides the opposite inference when it states: "I
16 replied to Ms. Julie Madison through Mr. Kaoru Kimura that her
17 ideas would not be realized if we used such new construction for
18 magnetic eyewear." See Def.'s Ex. 5, Nishioka Decl. at ¶3.

19 Thus, Defendant's evidence falls far short of raising a
20 genuine issue of material fact that Madison's ideas and drawings
21 constitute a prior art reference, especially in light of the
22 governing clear and convincing burden of proof. Conspicuously
23 absent from the record are the drawings themselves, upon which
24 the entirety of Defendant's counterclaim is premised. When
25 stripped to its essence, the evidence is nothing more than
26 testimony by the inventor herself, corroborated only by ambiguous
27 and inadmissible declarations. For this reason alone, partial
28 summary judgment in favor of Plaintiff is appropriate.

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2. WHETHER THE MADISON INVENTION WAS KNOWN OR
USED BY OTHERS OR DESCRIBED IN A PRINTED
PUBLICATION

Another crucial element of an anticipation defense is proving that the prior art reference was known or used by others, or described in a printed publication, prior to the invention of the device disclosed in the patent-in-suit. See 35 U.S.C. §102(a).

(1) Description in a Printed Publication

Anticipation by a prior publication occurs where the work adequately describes the invention in question and the work qualifies as a printed publication. See 1 Chisum, Chisum on Patents, §3.04 at 3-40. In order for a description to be "adequate", it must enable a person with ordinary skill in the art to not only comprehend the invention, but also to make it. See Beckman Instruments, Inc. v. LKB Produkter AB, 892 F.2d 1547, 1550 (Fed.Cir. 1989) (a prior art reference "must provide a description sufficient to teach a person of ordinary skill in the art how to make and use the apparatus or process"); Seymour v. Osborn, 78 U.S. 516 (1870).

In order for the prior art reference to qualify as a "printed publication" under 35 U.S.C. §102(a), it must have been "sufficiently accessible to those skilled in the art." In re Cronyn, 890 F.2d 1158, 1160 (Fed.Cir. 1989). This is because "dissemination and public accessibility are the keys to a legal determination whether a prior art reference was 'published'." Id. See also Deep Welding, Inc. v. Sciaky Bros., Inc., 417 F.2d 1227, 1235 (7th Cir. 1969) (distribution of paper at various technological conferences sufficed to constitute publication);

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1 Compare Preemption Devices, Inc. v. Minnesota Mining & Mfg. Co.,
2 732 F.2d 903 (Fed. Cir. 1984) ("the dissemination of six copies to
3 an individual was not a 'publication' . . .").

4 Here, Defendant's evidence fails to raise a genuine issue of
5 material fact that the Madison drawings qualify as a "printed
6 publication". The evidence does not indicate that the Madison
7 drawings, assuming that they exist, were made accessible to
8 members of the public. Rather, Madison testified that she did not
9 disclose any drawings in her notebook to Kimura, and that Kimura
10 saw only those drawings that were created in the course of the
11 parties' 1994 meeting in New Jersey. See See Madison Depo., Vol.
12 2 at 207-208. Moreover, there is no evidence that persons other
13 than Kimura ever saw Madison's drawings, including other
14 employees of Sunreeve. Finally, Madison testified that, while
15 there was no confidentiality agreement with Kimura, she expected
16 Kimura to refrain from disclosing her ideas and drawings to other
17 persons in the optical industry. See Madison Depo., Vol. 1 at
18 44:12-45:2; Madison Depo., Vol. 2 at 210-211.

19 Defendant's evidence also fails to raise a genuine issue of
20 material fact that the Madison drawings were sufficiently
21 detailed to enable a person with ordinary skill in the art to
22 both comprehend the invention and to make it. Indeed, the only
23 evidence submitted suggests that the Madison drawings disclosed
24 to Kimura were not sufficient to enable him to create the sample
25 requested by Madison. See Madison Depo., Vol. 2 at 190-192;
26 209:9-18; 177-178.⁷

27
28 "Q: And after you gave [Kimura] specifications [of the top-mounted monoblock design], he later came back to you and said that it could not

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(2) Public Knowledge or Use

Anticipation by prior knowledge requires that a complete and adequate description of the prior art reference must have been available to the public. See Rosemount, Inc. v. Beckman Instruments, Inc., 218 U.S.P.Q. 881 (C.D. Cal. 1983), aff'd 727 F.2d 1540 (Fed. Cir. 1984) ("the knowledge or use by others required by section 102(a) is public knowledge of a complete and operative device."). In addition, "the knowledge required by § 102(a) involves some type of public disclosure and is not satisfied by knowledge of a single person, or a few persons working together." Nat'l Tractor Pullers Ass'n v. Watkins, 205 U.S.P.Q. 892, 912 (N.D. Ill. 1980) (emphasis added).

Again, the inventor's testimony of prior knowledge or use must be corroborated by other evidence. See 1 Chisum, Chisum on Patents, §3.05[2] at 3-73.

In its opposition, Defendant argues that Madison provided her drawings "to Sunreeve via Kimura." See Def.'s Opp'n. at 14. However, Madison's testimony nowhere suggests that she disclosed her drawings to any Sunreeve employees other than Kimura. The

be done; is that correct?

A: Not right away. He said that they were talking about it, that they were discussing it with technical people.

Q: Right. But the ultimate conclusion was that it was not feasible?

A: At that time, yes.

Q: So it was at that point in time the manufacturer said it could not be reduced practice; would that be correct?

A: At that moment they had failed to come up with what I considered to be a workable alternative, or a workable or viable expression of the invention.

Q: And that was in 1994?

A: Yes."

See Madison, Vol. 2 at 177-178.

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1 inadmissible declaration of Nishioka, Deputy General Manager of
2 Sunreeve, itself suggests that he was only verbally informed of
3 Madison's ideas by Kimura, and does not indicate that Nishioka
4 ever viewed the drawings in question. See Nishioka Decl. at ¶2
5 (Kimura "reported to me that Ms. Julie Madison disclosed to him
6 her ideas regarding the new construction of end-piece parts for
7 magnetic eyewear, when he met with her prior to December 9, 1994
8 at the Anaheim Hilton Hotel in California, U.S.A."). Thus,
9 Defendant's evidence shows, at best, that Madison's drawings were
10 disclosed only to Kimura, which is insufficient as a matter of
11 law to constitute public knowledge. See Nat'l Tractor Pullers
12 Ass'n v. Watkins, 205 U.S.P.Q. at 912.

13 Having examined all of the evidence, the Court concludes
14 that Defendant has failed to raise a genuine issue of material
15 fact as to patent invalidity. Defendant has failed to submit the
16 Madison drawings, forcing the Court to rely on uncorroborated
17 inventor testimony that her invention constitutes a prior art
18 reference. In addition, there is no evidence that the Madison
19 drawings, even assuming that they qualify as a prior art
20 reference, were disclosed to the public in a manner constituting
21 a "printed publication," or that sufficient public knowledge or
22 use of such drawings occurred. As such, the Court need not reach
23 the third element of patent invalidity -- whether Madison's
24 drawings disclose each and every limitation of the invention
25 claimed in the the '207 Patent.

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1 VI. CONCLUSION

2 For the foregoing reasons, the Court GRANTS Plaintiff's
3 motion for partial summary judgment on Defendant's counterclaim
4 and affirmative defense of patent invalidity.
5

6 IT IS SO ORDERED.

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8 DATED: June 4, 2001

Louder G. Bird
9 LOURDES G. BIRD
10 United States District Judge
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